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| 09/603,222      | 06/26/2000  | Merel Epstein        | EMR-100-A-1         | 3220             |

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EXAMINER

MOHANDESI, JILA M

| ART UNIT | PAPER NUMBER |
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3728

DATE MAILED: 12/17/2001

14

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 14

Application Number: 09/603,222  
Filing Date: June 26, 2000  
Appellant(s): EPSTEIN, MEREL

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Charles D. Lacina  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 18, 2001.

**(2) *Related Appeals and Interferences***

There are no related appeals or interferences known to Appellants' legal representative.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

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The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 1, 7 and 8 do stand and fall together. **(8) Claims  
Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

|           |          |         |
|-----------|----------|---------|
| 5,170,570 | KANTRO   | 12-1992 |
| 3,099,267 | CHERNIAK | 07-1963 |
| 1,958,097 | SHAW     | 05-1934 |
| 5,345,701 | SMITH    | 09-1994 |
| 5,068,983 | MARC     | 12-1991 |

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kantro (5,170,572) in view of Cherniak (3,099,267) alone, or further in view of Shaw (1,958,097), Smith (5,345,701) and Marc (5,068,983). Kantro `572 teaches substantially all the limitations of the claims. For example a substantially circular balancing disc/cushion **20** is preferably made from a polymeric foam material of *high density* to provide the necessary support at the gait points. The top surface and bottom surface of disc/cushion **20** can also be angularly tapered through its thickness from its forward edge rearward with respect to each other as described at column 4, lines 14-49 and column 5, lines 37-41. Note that heel cushion/disc **19** is **tapered** at about 5 degrees. It is submitted the only reasonable conclusion (by comparison of column 4, line 32 to line 46) is that cushion **20** is also exactly **tapered** as described for cushion/disc **19**. Note that while Kantro `572 has chosen to use the term "cushions" for elements **19**, **20** and **21**, a careful review of the entire disclosure reveals that the "high density foam material" *must necessarily be sufficiently rigid* to alter the biomechanical balance and weight distribution by providing support to specific points. The structure and function, therefore, are submitted to be the same as applicant's, notwithstanding the use of the term "cushion". If for purposes of argument any doubt should subsequently be raised concerning whether the language in Kantro `572 "Polymeric foam material of a high density to provide the necessary support at the gait" at column 4, line 14-16 means that the discs will inherently will be substantially rigid. Cherniak `267 is cited to resolve that doubt. Cherniak `267 teaches that circular foot balancing devices (**50**, **52**, **54**) "may be rigid or yieldable", see column 2, lines 1-2. Therefore, it would have been obvious to one having ordinary skill in the art and in view of Cherniak `267 to make the circular

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balancing disc/cushion **20** of Kantro '572 more rigid or sufficiently rigid to ensure better support and weight distribution. The Shaw '097, Smith '701 and Marc '983 references are cited if for purposes of argument any doubt should subsequently be raised concerning the language in Kantro '572 "tapered along an axis directed at an angle" at column 4, line 46. Shaw '097 teaches an orthotic insole having angularly inclined wedge members having a transverse thickened portion **tapered** at about 3 degrees from one edge of the insole to a point beyond its longitudinal center line and restricted approximately to the portion of the insole that underlies the metatarsal heads of a superimposed foot, and another transverse thickened portion at the heel **tapered** from the opposite edge of the insole to a point beyond said center line and spaced a substantial distance from the heel end. Marc '983 teaches an insole having about a 2 degree **tapered** resilient base piece **20** adapted to conform to the foot and having a base surface and, a top surface inclined with respect to each other and a cupped periphery for accommodating the heel and extending to the arch area. Smith '701 teaches an orthotic device **20**, including a foot sole portion **30** together with a pair of correcting wedges **24** and **26 tapered** at about 4 degrees. The wedges **24** and **26** can be seen (Fig. **2b**) to change the angle of the bottom of the foot sole portion **30** relative to the ground, thus bringing the ground up to meet the soles of the patients foot. It will be appreciated that the wedges **24** and **26** can be formed at any angle, depending on the patients needs. These references both individually and collectively are representative of corrective wedge members having upper and lower surfaces angularly inclined by a small angle greater than zero (in the range of about 2 to 5 degrees) which are used with insoles and orthotics to enhance or correct biomechanical balance and weight distribution. Therefore, it would have been obvious to one having ordinary skill in the art and especially in view of each of Shaw '097,

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Marc '983 and Smith '701 to form the circular cushion member of Kantro '572 with a top surface and a bottom surface angularly inclined by a small angle greater than zero, such as in the 2-6 degree range, to further enhance or correct the biomechanical balance and weight distribution. With respect to the claims, the Shaw'097 (3 degrees), Marc '983 (2 degrees) and Smith '701 (4 degrees) references establish that the specific angle is a design choice depending on the shape and disposition with respect to the balancing foot disc/device and the routine optimization expected by one of ordinary skill in the art dependent upon the individuals biomechanical features and the desired correction and it would have been obvious over Shaw '097, Marc '983 and Smith '701 to select the angle between the upper and lower planar surfaces of the balancing device of Kantro '572 to be whatever angle is appropriate, including between about 2 to about 6 degrees. The circular balancing disc/cushion of Kantro '572 is inherently capable of being securable to the orthotic foot device in a plurality of incremental orientations.

**(11) Response to Argument**

Contrary to applicant's remarks that none of the art being applied discloses or suggests the 2-6 degrees angular relationship between the upper and lower surfaces, each of Kantro '572 (5 degrees), Shaw'097 (3 degrees), Marc '983 (2 degrees) and Smith '701 (4 degrees) teach balancing discs with 2-6 degrees angular relationship between their upper and lower surfaces as can clearly be seen by measurement of the drawings.

Inasmuch as applicant has claimed that leather, rubber or plastic is substantially non-compressible, the polymeric foam material of **high density** disc/cushion of Kantro '572 is also substantially non-compressible.

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the above references both individually and collectively are representative of corrective wedge members having upper and lower surfaces angularly inclined by a small angle greater than zero (in the range of about 2 to 5 degrees) which are used with insoles and orthotics to enhance or correct biomechanical balance and weight distribution. Therefore, it would have been obvious to one having ordinary skill in the art and especially in view of each of Shaw '097, Marc '983 and Smith '701 to form the circular cushion member of Kantro '572 with a top surface and a bottom surface angularly inclined by a small angle greater than zero, such as in the 2-6 degree range, to further enhance or correct the biomechanical balance and weight distribution.

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In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Contrary to applicant's argument that Kantro, Shaw, Smith and Marc are all directed to cushions and that a cushion can never impart balance. The above references both individually and collectively are representative of corrective wedge members having upper and lower surfaces angularly inclined by a small angle greater than zero (in the range of about 2 to 5 degrees) which are used with insoles and orthotics to enhance or correct biomechanical balance and weight distribution.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jila M. Mohandesi  
Examiner  
Art Unit 3728

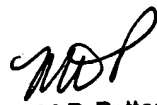
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December 11, 2001

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Primary Examiner



Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.